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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER
LANIER, BENJAMIN E

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2132	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	09/831,071	ISHIBASHI ET AL.
Office Action Summary	Examiner	Art Unit	
	Benjamin E. Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-395* is/are pending in the application.

    4a) Of the above claim(s) *105-395* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-104* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of Group I in the reply filed on 30 April 2007 is acknowledged.

Information Disclosure Statement

2.   The information disclosure statement filed 03 May 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because submitted copies of numerous cited references were provided in a foreign language. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

3.   The information disclosure statement filed 21 June 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a foreign language translation has not been provided for the AT reference. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

statement, including all certification requirements for statements under 37 CFR 1.97(e). See

MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 40, 66 are rejected under 35 U.S.C. 101 because the claimed invention is not

supported by either a specific asserted utility or a well established utility.

The claims include steps for transmitting identification data in an encrypted fashion and

unencrypted fashion for comparison by the receiver. However, the claims fail to point out the

problem being solved in these steps and subsequently the utility of the claimed process.

6.   Claims 40, 66 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since

the claimed invention is not supported by either a specific asserted utility or a well established

utility for the reasons set forth above, one skilled in the art clearly would not know how to use

the claimed invention.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 4-8, 13, 17-21, 26, 30-34, 39, 43-47, 52, 56-60, 65, 69-73, 78, 82-86, 91, 95-99,

104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

9.   Claims 4, 17, 30, 43, 56, 69, 82, 95 recite, "means for adding signature data for checking illegal data and tampering to said contents key encrypted by said individual key and said identification information encrypted by said distribution key," which renders the claims indefinite because it is unclear where the signature data is added.

10.   Claim 5 recites the limitation "album contents data" in line 4. There is insufficient antecedent basis for this limitation in the claim.

11.   Claim 6 recites the limitation "album key data" in line 6. There is insufficient antecedent basis for this limitation in the claim.

12.   Claim 6 recites the limitation "said contents keys" in line 6-7. There is insufficient antecedent basis for this limitation in the claim.

13.   Claim 6 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

14.   Claims 13, 27, 39, 52, 65, 78, 91, 104 recite, "another specific contents data of said...," which renders the claims indefinite because it is unclear to what 'said' is referring.

15.   Claim 18 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

16.   Claim 19 recites the limitation "album key data" in line 5. There is insufficient antecedent basis for this limitation in the claim.

17.   Claim 19 recites the limitation "the contents keys" in line 6. There is insufficient antecedent basis for this limitation in the claim.

18.   Claim 19 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

19.   Claim 31 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

20.   Claim 32 recites the limitation "album key data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

21.   Claim 32 recites the limitation "said contents keys" in line 6. There is insufficient antecedent basis for this limitation in the claim.

22.   Claim 32 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

23.   Claim 44 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

24.   Claim 45 recites the limitation "album key data" in line 5. There is insufficient antecedent basis for this limitation in the claim.

25.   Claim 45 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

26.   Claim 57 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

27.   Claim 58 recites the limitation "album key data" in line 5. There is insufficient antecedent basis for this limitation in the claim.

28.   Claim 58 recites the limitation "said contents keys" in line 6. There is insufficient antecedent basis for this limitation in the claim.

29.   Claim 58 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

30.   Claim 70 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

31.   Claim 71 recites the limitation "album key data" in line 6. There is insufficient antecedent basis for this limitation in the claim.

32.   Claim 71 recites the limitation "said contents keys" in line 6. There is insufficient antecedent basis for this limitation in the claim.

33.   Claim 71 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

34.   Claim 83 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

35.   Claim 84 recites the limitation "album key data" in line 5. There is insufficient antecedent basis for this limitation in the claim.

36.   Claim 84 recites the limitation "said contents keys" in line 6. There is insufficient antecedent basis for this limitation in the claim.

37.   Claim 84 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

38.   Claim 96 recites the limitation "album contents data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

39.   Claim 97 recites the limitation "album key data" in line 6. There is insufficient antecedent basis for this limitation in the claim.

40.   Claim 97 recites the limitation "said contents keys" in line 6-7. There is insufficient antecedent basis for this limitation in the claim.

41.   Claim 97 recites, "adding a signature of said information sending apparatus adds said signature data to said contents key encrypted by said individual key and identification information encrypted by said distribution key respectively," which renders the claim indefinite because it is unclear where the signature is added.

42.   Claims 5-8, 18-21, 31-34, 44-47, 57-60, 70-73, 83-86, 96-99 include an if condition with no corresponding else condition. Therefore, the claims are indefinite.

Claim Rejections - 35 USC § 102

43.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

44.   Claims 1-4, 14-17, 27, 29, 30, 40-43, 53-56, 66, 68, 69, 79-82, 92, 94, 95 are rejected

under 35 U.S.C. 102(e) as being anticipated by Venkatesan, U.S. Patent No. 6,801,999.

Referring to claims 1, 14, 16, 27, 29, 40, 53, 55, 66, 68, 79, 81, 92, 94, Venkatesan discloses a

content protection system using watermarking wherein audio files are protected using embedded

watermarks (Col. 10, lines 13-14, 23-26). The watermark includes a product identification value

(PID) and a publisher (vendor) identification value (VID)(Figure 5, 520 & Col. 13, lines 26-30 &

Col. 24, lines 31-33), which meets the limitation of information sending apparatus comprises

means for adding said identification information to said contents data in order to make a

comparison with said identification information encrypted by said distribution key. The publisher

generates a license for the content to be protected that is distributed to the requesting client

(Figure 5, 550). The license includes the PID and VID (Col. 24, lines 17-34) and is encrypted

with the public key of the requesting client (Col. 30, lines 38-40), which meets the limitation of

said information sending apparatus comprises means for holding identification information to

identify said information sending apparatus encrypted by a distribution key unique to said

information receiving apparatus. The watermarked content and license, are then distributed by

the publisher to a requesting user, where the watermark content is downloaded to the client PC

(Col. 14, lines 17-19, 37-40 & Figure 5), which meets the limitation of said information sending

apparatus comprises means for sending said identification information encrypted by said

distribution key together with said contents data with said identification information added, and

said information receiving apparatus comprises means for receiving said contents data with said

identification added and said identification information encrypted by said distribution key. The

client PC then decrypts the license using the secret key corresponding the public key (Col. 31,

lines 48-50), which meets the limitation of means for holding said distribution key, means for

decrypting by said distribution key said identification information encrypted by the distribution

key. When a user attempts to access the watermark content, a verifier compares the VID and PID

values contained in the header of the license to the actual VID and PID values extracted from the

watermark embedded in the object to determine if identical matches exist between the actual and

expected values of the PID, and between the actual and expected values of the VID (Col. 25,

lines 6-12), which meets the limitation of means for comparing said identification information

added to said contents data with said decrypted identification information.

Referring to claims 2, 3, 15, 41, 42, 54, 80, Venkatesan discloses that the license contains

rights used to enforce access restrictions to the content (Col. 26, lines 52-54), which meets the

limitation of means for generating handling policies, that is, generating contents handling

policies prescribing conditions for using said contents data and storing said identification

information. The license can be included with the content filed (Figure 6, 607), which meets the

limitation of said means for adding identification information adds said contents handling

policies to said contents data, said means for adding identification information of said

information sending apparatus directly adds said identification information to said contents data.

Referring to claims 4, 17, 30, 43, 56, 69, 82, 95, Venkatesan discloses that the content is

encrypted with a symmetric encryption key (Figure 6 & Col. 31, lines 62-65), which meets the

limitation of means for encrypting said contents data by a predetermined content key. The

symmetric encryption key is included in the license (Col. 31, lines 63-64) that is encrypted with

the public key of the client PC (Col. 30, lines 38-40), which meets the limitation of means for

encrypting said contents key by a predetermined individual key. The license also includes a

digital signature (Col. 30, lines 29-38), which meets the limitation of means for adding signature

data for checking illegal data tampering to said contents keys encrypted by said individual key

and said identification information encrypted by said distribution key. The client PC verifies the

signature in the license (Col. 31, lines 55-58), which meets the limitation of said information

receiving apparatus comprises means for verifying said signature data.

Claim Rejections - 35 USC § 103

45.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

46.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness
       or nonobviousness.

47.   Claims 5-13, 18-26, 28, 31-39, 44-52, 57-65, 67, 70-78, 83-91, 93, 96-104 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Venkatesan, U.S. Patent No. 6,801,999, in

view of Downs, U.S. Patent No. 6,226,618. Referring to claims 5, 6, 18, 19, 31, 32, 44, 46, 57,

58, 70, 71, 83, 84, 96, 97, Venkatesan discloses that the content is encrypted with a symmetric

encryption key (Figure 6 & Col. 31, lines 62-65). The symmetric encryption key is included in

the license (Col. 31, lines 63-64) that is encrypted with the public key of the client PC (Col. 30,

lines 38-40). The license also includes a digital signature (Col. 30, lines 29-38), which meets the

limitation of said means for adding a signature of said information sending apparatus adds said

signature data to said contents data encrypted by said content key. The client PC verifies the

signature in the license (Col. 31, lines 55-58), which meets the limitation of said means for

verifying a signature of said information receiving apparatus verifies said signature data.

Venkatesan does not specify that the content can include entire albums. Downs discloses that a

content distribution system where the distributed content includes entire albums (Col. 81, lines

28-30). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide entire albums in the content protection system of Venkatesan so that the

end user of the client PC in Venkatesan would not have to individually purchase each song in the

album when purchasing an entire album is desired.

Referring to claims 7, 20, 33, 46, 59, 72, 85, 98, Venkatesan discloses that the license

contains rights used to enforce access restrictions to the content (Col. 26, lines 52-54), which

meets the limitation of means for generating handling policies, that is, generating contents

handling policies prescribing conditions for using said contents data and storing said

identification information. The license also includes a digital signature (Col. 30, lines 29-38).

which meets the limitation of said means for adding a signature of said information sending

apparatus adds said signature data to said contents data handling policies. The client PC verifies

the signature in the license (Col. 31, lines 55-58), which meets the limitation of said means for

verifying a signature of said information receiving apparatus verifies said signature data.

Venkatesan does not specify that the content can include entire albums. Downs discloses that a

content distribution system where the distributed content includes entire albums (Col. 81, lines

28-30). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide entire albums in the content protection system of Venkatesan so that the

end user of the client PC in Venkatesan would not have to individually purchase each song in the

album when purchasing an entire album is desired.

Referring to claims 8, 11, 12, 21, 24, 25, 34, 37, 38, 47, 50, 51, 60, 63, 64, 73, 76, 77, 86,

89, 90, 99, 102, 103, Venkatesan discloses that the content has corresponding price information

(Figure 5, 540). Venkatesan does not disclose that the price information is digital signed and

verified. It would have been obvious to one of ordinary skill in the art at the time the invention

was made to digital sign the price information so that the end user purchasing the content could

verify that the price information originated from an authorized location (i.e. publisher) as taught

by Downs (Col. 13, line 49'– Col. 14, line 17). Venkatesan discloses that the client PC verifies

the signature in the license (Col. 31, lines 55-58), which meets the limitation of said means for

verifying a signature of said information receiving apparatus verifies said signature data.

Venkatesan does not specify that the content can include entire albums. Downs discloses that a

content distribution system where the distributed content includes entire albums (Col. 81, lines

28-30). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide entire albums in the content protection system of Venkatesan so that the end user of the client PC in Venkatesan would not have to individually purchase each song in the album when purchasing an entire album is desired.

Referring to claims 9, 22, 35, 48, 61, 74, 87, 100, Venkatesan discloses that the license contains rights used to enforce access restrictions to the content (Col. 26, lines 52-54), which meets the limitation of said means for generating handling policies of said information sending apparatus generates said contents handling policies storing signature verification information representing whether or not said signature data added to said contents data encrypted by said content key is verified. The client PC verifies the signature in the license (Col. 31, lines 55-58), which meets the limitation of said means for verifying a signature of said information receiving apparatus verifies said signature data added to said contents data encrypted by said content key only when instructed to verify said signature data added to said contents data encrypted by said content key based on said signature verification information stored in said contents handling policies.

Referring to claims 10, 23, 36, 49, 62, 75, 88, 101, Venkatesan does not specify that the content can include entire albums. Downs discloses that a content distribution system where the distributed content includes entire albums (Col. 81, lines 28-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide entire albums in the content protection system of Venkatesan so that the end user of the client PC in Venkatesan would not have to individually purchase each song in the album when purchasing an entire album is desired.

Referring to claims 13, 26, 39, 52, 65, 78, 91, 104, Venkatesan discloses that the license

contains rights used to enforce access restrictions to the content (Col. 26, lines 52-54), which

meets the limitation of said means for generating handling policies of said information sending

apparatus generates said contents handling policies prescribing that another specific contents

data of said may be acquired only when said specific contents data is acquired.

Referring to claims 28, 67, 93, Venkatesan discloses that the user of the client PC

conducts a transaction to purchase the content (Figure 5, 540). The user receives a license for the

content containing rights used to enforce access restrictions to the content (Col. 26, lines 52-54),

which meets the limitation of said means for receiving receives said contents data sent from said

information sending apparatus and contents handling policies prescribing conditions for using

said contents data added to the contents data and storing said identification information. When a

user attempts to access the watermark content, a verifier compares the VID and PID values

contained in the header of the license to the actual VID and PID values extracted from the

watermark embedded in the object to determine if identical matches exist between the actual and

expected values of the PID, and between the actual and expected values of the VID (Col. 25,

lines 6-12), which meets the limitation of said means for comparing compares said identification

information stored in said contents handling policies with said identification information that is

decrypted. Venkatesan does not disclose that the purchasing of contents is performed subsequent

to a positive comparison between identification information embedded in the content and

identification information included in the content. Downs discloses a content distribution system

wherein content usage restrictions are transmitted to the user upon purchase request but prior to

actual completion of transactions (Col. 18-19, see steps 133-145). It would have been obvious to
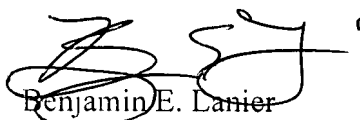
one of ordinary skill in the art at the time the invention was made to transmit the access rights of

Venkatesan in a different license, such as the transaction SC of Downs, prior to completion of

the transaction for content and distribution of content license to the client PC, in order to provide

the end user of the client PC the opportunity to review the actual rights afforded to them with

respect to the content prior to purchasing the rights.

Conclusion

48.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805.

The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin E. Lanier